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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,755

03/30/2005

Emmanuel Miette

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EXAMINER

EPSTEIN, BRIAN M

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

07/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/529,755	<b>Applicant(s)</b> MIETTE, EMMANUEL	
	<b>Examiner</b> BRIAN EPSTEIN	<b>Art Unit</b> 3628	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 12, 14 and 16.  
 Claim(s) withdrawn from consideration: 13, 15.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Below.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/JOHN W HAYES/  
 Supervisory Patent Examiner, Art Unit 3628

/B. E./  
 Examiner, Art Unit 3628  
 July 21, 2009

As per applicants arguments concerning the rejection of claim 12 under §101, Examiner notes that the mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al. Further, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). That is, at least as far as claim 12, the claimed method does not require any particular apparatus. The apparatus cited in the preamble (the sorting machine) is only used to form an image of each item to perform OCR and then to forward each item to a sorting output. The claim steps themselves however, merely require identifying, detecting and computing, none of which require any particular apparatus and could certainly be completed in a persons head, for example. If the destination address is not recognized unambiguously (by the machine), a person could identify, detect and compute. The machine in the preamble is not required, as per the claim, to perform those steps. As a result, examiner disagrees with applicants contention that claim 12 is statutory under U.S.C. §101.

As per applicants arguments concerning the rejection of claims 12, 14, and 16 under §103, examiner notes a zip code can certainly be a delivery round. Vaghi teaches detecting if the mailed addresses are in a single zip code, and then in response to detecting if the mailed address are in a single zip code, computing the volume of mail for that zip code, comparing the volume for the zip code to a threshold, and then forwarding the mail to a "sorting output," if the volume meets a minimum standard (see, Paragraphs 0086-0089). Examiner notes, as indicated above, that the preamble is generally accorded little patentable weight. The claim limitations themselves, do not require making a sorting or routing decision whatsoever, as argued by applicant. All the claims require is to determine delivery points corresponding to several ambiguous possible delivery points, detecting if those points are in a single delivery round, and computing a volume of mail in the delivery round, and comparing that volume to a threshold to then sort. Examiner notes that applicants arguments on Page 9 do not correlate to the claim language. For example, Applicant recites, "if they are in the same delivery round, checks to see if that delivery round has a high volume of mail to be delivered." The last step of the claim merely recites, "in response to said detection, computing a volume of mail for...comparing to threshold...to forward..." This language is certainly broad enough to be read on by Vaghi, regardless as to whether Vaghi has anything to do with sorting. Examiner notes Vaghi was combined "in order to reduce the postage costs of the routed mail pieces by Ross by presorting." (see page 7 of the Final Rejection).

Examiner notes that claims are read with broadest reasonable interpretation. Examiner does not dispute/argue that applicants invention, as argued in the after final is or is not patentable. However, the claim limitations do not specifically recite the process argued by applicant. Claims 12, 14, and 16, as claimed, can certainly be interpreted as indicated in examiners Final Rejection.

The claim amendments filed July 16, 2009 have not been entered as they do not simplify issues for appeal and further since the amendment to claim 16 requires a new search and further consideration.